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Docket No.: 412692000401

REMARKS

Claims 1-35 are pending in the present application. By virtue of this response, claim 1 has been amended. The specification has been amended to update related application information. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. No new matter has been added.

Applicant wishes to thank Examiner Lin for the courtesy of a telephone conversation held October 14, 2003 between the Examiner and Applicant's undersigned representative during which the prior art and the amendment to claim 1 presented herein were discussed.

Rejections under 35 U.S.C. §102

Claims 1-10, 14-18, 24, 27, 28, 32 and 35 were rejected under 35 U.S.C. §102(e) as being anticipated by Sing et al. (US 6,183,497).

Sing et al. teaches an absorbable sponge containing a contrasting agent that can be introduced into a biopsy tract or other puncture wound site. More particularly, the contrasting agent is described as being "incorporated in the matrix of the sponge", that is, the contrasting agent is "substantially dispersed throughout the sponge." (Sing et al. at column 3, lines 45-50). As such, the contrasting agent allows for visualization of the entirety of the sponge through the use of appropriate imaging systems.

By contrast, claim 1, as now amended, is directed to a subcutaneous cavity marking device that comprises the recited at least one filler body and "at least one detectable marker affixed to said filler body to mark a particular section or sections of the device." Support for the amendment can be found, e.g., at page 17, paragraph 65, of the specification and in the embodiments of the invention depicted in various figures, including e.g. Figs. 1A-1C and 3B-3D. The inclusion of a detectable marker element that allows for the marking of a particular section or sections of the device, including interior and/or peripheral sections of the device, is neither taught nor suggested by the Sing et al. sponge which contains a contrasting agent dispersed throughout.

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Applicant therefore respectfully requests withdrawal of the rejection as to claim 1 and claims 2-10, 14-18, 24, 27, 28, 32 and 35 depending therefrom.

Rejections under 35 U.S.C. §103

Claims 19-21 and 29-31 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sing et al. As grounds for the rejection, the Examiner specifically states "Sing fails to teach having a particular shape for the marker" but that "it is an obvious matter of design choice . . . to select a particular shape for the marker, or make it hollow, in order to distinguish it from the surrounding body, and so that it may maximize its fit in the body . . ." (Office Action, page 3). Applicant assumes that Examiner's use of the term "marker" here refers to the Singh et al. sponge as a whole. For reasons previously discussed, Singh et al. fails to teach or suggest the subcutaneous cavity marking device of main claim 1 comprising the recited at least one filler body and "at least one detectable marker affixed to said filler body to mark a particular section or sections of the device." Sing et al. therefore likewise fails to teach or suggest the subject matter of dependent claims 19-21 and 29-31, which are directed to subcutaneous cavity marking devices of claim 1 where the detectable marker or the filler body further has particular recited configurations. Applicant therefore respectfully requests withdrawal of the rejection as to these claims.

Claims 11-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sing as applied to claim 1 and further in view of Burbank et al. (US 6,151,034). Burbank et al. is relied upon for teaching a palpable biopsy marker. Again, as previously discussed, Singh et al. does not teach or suggest the subcutaneous cavity marking device of main claim 1. The Burbank et al. teachings of a palpable biopsy marker do not cure the deficiencies of Sing et al. with respect to claim 1. Sing et al. and Burbank et al., either alone or in combination, therefore cannot teach or suggest all the limitations of dependent claims 11-13. Applicant therefore respectfully requests withdrawal of the rejection as to these claims.

Allowable Subject Matter

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Applicant acknowledges that claims 22, 23, 25, 26, 33 and 34 were objected to but indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In view of the above remarks, Applicant submits the claims are allowable in their present dependent form.

Conclusion

Each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 412692000401. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: October 21, 2003

Respectfully submitted,

By Cameron A. King
Cameron A. King
Registration No.: 41,897
MORRISON & FOERSTER LLP
425 Market Street
San Francisco, California 94105
(415) 268-6524

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